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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,205	03/03/2004	Daniel F. Broderick	CL/V-31796B/DI	4188

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CIBA VISION CORPORATION
PATENT DEPARTMENT
11460 JOHNS CREEK PARKWAY
DULUTH, GA 30097-1556

EXAMINER

STULTZ, JESSICA T

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/792,205

Applicant(s)

BRODERICK ET AL.

Examiner

Jessica T. Stultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 35-39 in the reply filed on August 22, 2005, is acknowledged. Accordingly, claims 40-68 were canceled as being drawn to a non-elected species.

Examiner's Comments

For applicant's information, it appears that an information disclosure statement was filed on March 3, 2004; however, no 1449 for this IDS was found in the application file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Gao et al.

Regarding claim 35, Gao et al discloses a system for configuring a customized contact lens for a user (Column 23, line 15-Column 24, line 12, wherein the system "10" simulates contact lenses on patient's eyes, Figures 21 and 22) the system comprising: means for displaying a template eye image to assist the user in visualizing selected options for a customized contact lens (Column 23, line 15-Column 24, line 12, wherein the system "10" acquires a digital image of the face and displays the image on a screen as disclosed in Column 6, line 14-Column 7, line 19, Figures 1-2); graphical display and interface means for displaying a plurality of contact lens

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selection options to the user (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the options from database “16” are displayed on the template eye through the interface, i.e. touch screen “26”, Figures 1-2 and 21-22); the information including a plurality of selectable and modifiable lens parameters (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the options are held in database “16”, Figures 1-2 and 21-22), the means in communication with the means for displaying a template eye image (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the options from database “16” are displayed on the template eye through the CPU “38”, Figures 1-2 and 21-22); means for sending a request to order a contact lens incorporating lens characteristics selected by the user (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the request is entered on the touch screen “26” or keyboard “28” and processed through the CPU “38”, Figures 1-2 and 21-22); means for receiving the ordering request; and means for manufacturing a contact lens incorporating the characteristics selected by the user (Column 10, lines 11-22, wherein the contact lens is manufactured with the selected parameters).

Regarding claim 36, Gao et al further discloses means for deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user (Column 23, line 15-Column 24, line 12, wherein a color pattern is applied to the contact lens which changes the appearance of the eye, Figures 21-22).

Regarding claim 37, Gao et al discloses a system for configuring a customized contact lens for a user (Column 23, line 15-Column 24, line 12, wherein the system “10” simulates contact lenses on patient’s eyes, Figures 21 and 22) the system comprising: an image input device for obtaining a graphical template eye image from the user (Column 23, line 15-Column

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24, line 12, and Column 6, line 14-Column 7, line 19, wherein the system "10" acquires a digital image of the face using camera "16", Figures 1-2, and 21-22); a graphical user display in communication with the device for visualizing the template eye image (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the template eye is displayed on the touch screen "26", Figures 1-2 and 21-22), said user display displaying one or more selectable lens characteristics in conjunction with the template eye image (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the options from database "16" are displayed on the template eye through the interface, i.e. touch screen "26", Figures 1-2 and 21-22); a user interface linked to the display for selecting one or more of the selectable lens characteristics (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the selection is entered on the touch screen "26" or keyboard "28" and processed through the CPU "38", Figures 1-2 and 21-22); a server in communication with the user interface (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the options from database "16" are displayed on the template eye through the CPU, i.e. server "38", Figures 1-2 and 21-22), the server receiving selections of the lens characteristics from the user interface and incorporating the selected one of the lens characteristics into a modified template eye image for display (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the request is entered on the touch screen "26" or keyboard "28" and processed through the CPU "38", Figures 1-2 and 21-22); a database accessible by the server containing information relating to the user and the available selectable lens characteristics (Column 23, line 15-Column 24, line 12, and Column 6, line 14-Column 7, line 19, wherein the lens options are held in database "16", Figures 1-2 and 21-22); and a fabrication system in

communication with the server for receiving information relating to the modified template eye image and manufacturing a contact lens based on the information (Column 10, lines 11-22, wherein the contact lens is manufactured with the selected parameters).

Regarding claim 38, Gao et al further discloses that the interface further comprises a subsystem for deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user (Column 23, line 15-Column 24, line 12, wherein a color pattern is applied to the contact lens which changes the appearance of the eye, Figures 21-22).

Regarding claim 39, Gao et al further discloses that the database further comprises information generally available over the Internet, and the information being searchable by an intelligent agent originating from the server (Column 10, lines 11-22, wherein the selected parameters, are available from the manufacturer through the internet).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cox et al, Soatto, and Streibig are cited as having some similar structure to the claimed invention.

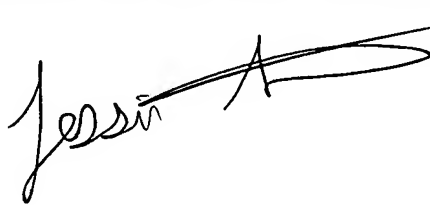
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica Stultz
Patent Examiner
AU 2873
September 15, 2005



JORDAN SCHWARTZ
PRIMARY EXAMINER